REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on April 19, 2005, and the references cited therewith.

Claims 16 and 18 are amended and new claims 35-37 are added; as a result, claims 10-16 and 18-37 are now pending in this application. Please charge any required fee to deposit account 19-0743. The amendments to claims 16 and 18, and new claim 35 are supported in the last paragraph (page 32) of the specification before the claims, and page 10 lines 17-21. No new matter is added.

Argument

Rejection Under 35 U.S.C. § 102(e)

1)   The Applicable Law for Rejections Under 35 U.S.C. § 102(e)

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless –

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

MPEP 2131 notes:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset

time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

2)   The 35 U.S.C. § 102(e)Rejections

Claims 10-16 and 18-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson et al. (hereinafter "Anderson") U.S. Patent Application No. 20040158524. Applicants respectfully appeal the rejection. Anderson describes a system wherein a customer accesses a web page using the customer's computer and browser, is connected to a sales agent who is using the agent's browser and computer, and the customer and agent are connected to one another to converse by text windows and/or telephone.

Analysis

Anderson fails to anticipate the present claims, since it does not contain each and every element as set forth in the claim, either expressly or inherently described (*See Verdegaal, supra*). Anderson fails to teach or suggest storing both the second transaction by the service consumer (Anderson's "user") and the first transaction by the service provider (Anderson's "financial services provider" or "Conductor host") into the database, wherein access to the transactions is selectively enabled to the service consumer/customer based on an identification of the service consumer, and wherein the transactions are then accessed by the service consumer/customer. The Office Action mailed April 19, 2005, points to Figs. 1, and 4, neither of which show a plurality of transactions for a database including one from a service consumer and one from a service provider.

Although Anderson uses the word "transaction," the meaning of that word as used by Anderson is of a credit or debit card transaction (see paragraph [0027]) and is not the same as

"transaction" as used in the present application (i.e., in the present invention, the transactions are computer-actionable data that add to or modify information in a database).

Further, as far as Applicant can determine, Anderson does not receive any transactions from a service consumer, and in fact in paragraph [0033] says "Preferably, users may view and manipulate only their own financial data. Furthermore, **users may not alter the data.** Preferably, users have the option of downloading the financial data to an accounting software package such as Intuit's Quicken. or a word-processing program such as Novell's WordPerfect." In contrast, the invention recited in claim 10 of the present application provides "**selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled.**" The Examiner points to paragraph [0033] and the abstract of Anderson. Applicant can find no teaching or suggestion in these sections of Anderson cited by the Examiner that enable the customer, based on identification of the customer, to access those defined transactions in the database system (as recited in claim 10 and claim 14).

In contrast, the present invention as recited in claims 10 and 14 provides a method (or media having the method) comprising:

> receiving a plurality of **transactions for the database system** including a **first transaction from a service provider** and a **second transaction from a service consumer**, wherein the first and the second transactions are each associated with the service consumer;
> storing the plurality of transactions into the database system; and
> selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled. *(emphasis added)*

The recited combination of transactions and the selective enabling of accesses to the database distinguishes the present invention from Anderson. Accordingly, reconsideration and allowance of these claims and their dependent claims is respectfully requested.

As to dependent claims 11, 15, and 32, Anderson describes a credit or debit card transaction. There is nothing about any docketing function or provider. The Office Action has failed to provide a *prima facie* case of anticipation. The claimed combination where the method further includes "receiving transactions by a docketing provider" is clearly distinguished. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 12, 20, 26 and 33, Anderson describes nothing of pending action items, but rather is a record of past credit-card transactions on a daily basis. In contrast, this feature of the present invention is useful for such professions as law and others. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claim 16, Anderson describes a credit card transaction database viewing service, not a database to support a patent application service provider. In contrast, the present invention is useful for such professions as law and others. Reconsideration and allowance of this claim is respectfully requested.

As to claim 18, this claim and its dependent claims are means-plus-function claims, and must be examined under 35 U.S.C. § 112 paragraph 6, to be the structure and acts described in the present invention and equivalents thereof. The Office Action has failed to provide a reference with the required equivalents as analyzed under 35 U.S.C. § 112 paragraph 6. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 22 and 28, Anderson does not describe extracting a database transaction from an electronic message. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 23 and 29, Anderson does not describe an input device for a database transaction, but rather a generic input device. Applicant cannot find any indication that this input device is used for entering a database transaction in Anderson. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to the remaining claims not separately discussed above, each is dependent on a claim that appears allowable, as discussed above. Further, each describes further limitations that form a combination with the respective parent claim, and these combinations are also not described in the cited reference. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Applicant respectfully request reconsideration of the rejections of claims 10-16 and 18-34. New claims 35-37 are added to more fully describe the claimed invention. Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.111
Serial Number: 09/658,795
Filing Date: September 11, 2000
Title: Transaction-Based Object-Oriented Multipart Database Method and Apparatus

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Attorney Docket: 750.006US1

Conclusion

It is respectfully submitted that the cited art neither anticipates nor renders the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 10-16, 18-34, and new claims 35-37 should be allowed in view of the arguments presented. Reversal of the Examiner's rejections of claims 10-16 and 18-34 is respectfully requested.

The Examiner is invited to telephone Applicant's attorney (952-278-3501) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
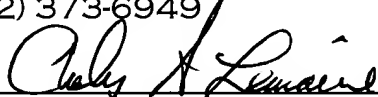
Respectfully submitted,

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DATE 19 July 2005   BY _____
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CERTIFICATE UNDER 37 C.F.R. 1.8: I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on this 19th day of July 2005.

_____Charles A. Lemaire_____   _____
Name   Signature